

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

The Applicants wish to draw the Examiner's attention to the Applicants' related co-pending applications and issued patents (see Appendix A) directed to nanoparticles and methods of preparation and use thereof. Many office actions have already issued for these cases; a number of cases have already granted.

As mentioned in the prior response to the Office action dated March 21, 2003, the Applicants note that the Examiner did not return executed copies of the PTO 1449 form for the 6<sup>th</sup> Supplemental IDS that was hand delivered to the Examiner on September 9, 2002. The Applicants again request that the Examiner fully execute the PTO 1449 form for the 6<sup>th</sup> Supplemental IDS and return a copy of the executed PTO 1449 form to the undersigned representative. A copy of the 6<sup>th</sup> Supplemental IDS, associated PTO 1449 form, and PTO stamped postcard acknowledging receipt of the IDS, PTO 1449 form was attached to the Applicants' prior response. The Examiner is requested to contact the undersigned representative if the Examiner would like to have another copy of the references.

Claims 433-486 were pending in this application. Claims 466 and 482 to 486 were cancelled without prejudice and claims 433, 467, 474, 476 and 477 were amended to further clarify the applicants' invention and/or to correct claim dependency. Support for the amendment of claim 433 can be found in cancelled claim 466. Accordingly, no new matter has been introduced into this application as a result of the present amendment. Claims 433-465 and 467-481 are now pending in this application.

Consideration and entry of this amendment into this case is respectfully requested. The Applicants believe that this amendment does not raise any new issues nor require any burdensome search. The Applicants further believe that this response places this application into allowable condition or in better form for consideration on appeal.

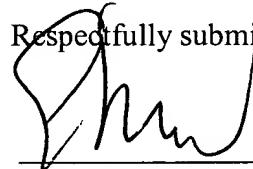
Turning to the office action, claims 433-443, 458-465, 474, and 476-486 stand rejected under 35 U.S.C section 102(e) as being anticipated by Yguerabide (U.S. Patent No. 6,214,560) ("Yguerabide"). The Examiner, however, has found claims 446-454 to be allowable. With respect to claims 455-457, 466-473, and 475, the Examiner had further indicated that such claims would be allowable if rewritten in independent form including all of the limitations of the

base claim and any intervening claims. In light of the present amendment, the Applicant submits that the claims are now in condition for an allowance. The presently claimed composition and kit are neither taught, made obvious, or suggested by Yguerabide. Accordingly, withdrawal of the section 102(e) rejection of the claims based on Yguerabide is in order and is respectfully requested.

Reconsideration of this application is respectfully requested and a favorable determination is earnestly solicited. The Examiner is invited to contact the undersigned representative if the Examiner believes that this would be helpful in expediting the prosecution of this application.

Dated: 1/28/04

Respectfully submitted,

  
Emily Miao  
Reg. No. 35,285

McDonnell Boehnen  
Hulbert & Berghoff, Ltd.  
300 South Wacker Drive  
Chicago, IL 60606  
Telephone: 312-913-0001  
Facsimile: 312-913-0002



## APPENDIX A

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
00-653-A	U.S. 09/927,777 Filed 8/10/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton, Garamella, Li, Park/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	ALLOWED
00-713-B1	09/923,625 Filed 8/7/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	ALLOWED
00-713-C	09/344,667, filed 6/25/99	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	U.S. Patent No. 6,361,944, issued 3/26/02
00-713-I	U.S.S.N 09/603,830 Filed 6/26/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	U.S. Patent No. 6,506,564, issued 1/14/03
00-713-I-1	09/961,949 9/20/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton;	U.S. Patent No. 6,582,921, issued June 24, 2003

January 28, 2004

Page 2 of 6

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
		NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	
00-713-I-2	09/957,318 9/20/01	See 00-713-I-1	ALLOWED
00-713-I-3	09/957,313 9/20/01	See 00-713-I-1	U.S. Patent No. 6,645,721, issued 11/11/03
00-713-I-4	09/966,491 9/28/01	See 00-713-I-1	U.S. Patent No. 6,610,491, issued August 26, 2003
00-713-I-5	09/966,312 9/28/01	See 00-713-I-1	U.S. Patent No. 6,673,548, issued January 6, 2004
00-713-I-6	09/967,409 9/28/01	See 00-713-I-1	ALLOWED
00-713-I-7	09/974,500 10/10/01	See 00-713-I-1	ALLOWED
00-713-I-8	09/974,007 10/10/01	See 00-713-I-1	PENDING
00-713-I-9	09/973,638 10/10/01	See 00-713-I-1	PENDING
00-713-I-10	09/973,788 10/10/01	See 00-713-I-1	ALLOWED
00-713-I-11	09/975,062 10/11/01	See 00-713-I-1	U.S. Patent No. 6,677,122, issued January 13, 2004
00-713-I-12	09/975,376 10/11/01	See 00-713-I-1	PENDING
00-713-I-13	09/975,384 10/11/01	See 00-713-I-1	PENDING

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
00-713-I-14	09/975,498 10/11/01	See 00-713-I-1	ALLOWED
00-713-I-15	09/975,059 11/11/01	See 00-713-I-1	PENDING
00-713-I-16	09/976,601 10/12/01	See 00-713-I-1	PENDING
00-713-I-17	09/976,968 10/12/01	See 00-713-I-1	PENDING
00-713-I-18	09/976,971 10/12/01	See 00-713-I-1	U.S. Patent No. 6,682,895, issued 1/27/04
00-713-I-19	09/976,863 10/12/01	See 00-713-I-1	PENDING
00-713-I-20	09/976,577 10/12/01	See 00-713-I-1	ALLOWED
00-713-I-21	09/976,618 10/12/01	See 00-713-I-1	PENDING
00-713-I-22	09/981,344 10/15/01	See 00-713-I-1	ALLOWED
00-713-I-23	09/976,900 10/12/01	See 00-713-I-1	PENDING
00-713-I-24	09/976,617 10/12/01	See 00-713-I-1	ALLOWED
00-713-I-25	09/976,378 10/12/01	See 00-713-I-1	PENDING
00-713-i-26	10/410,324 04/10/03	See 00-713-I-1	PENDING
00-713-L	U.S.S.N. 09/693,005 Filed 10/20/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI	U.S. Patent No. 6,495,324, issued 12/17/02

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
		DES ATTACHED THERETO AND USES THEREFORE	
<b>00-713-M</b>	U.S.S.N. 09/693,352 Filed 10/20/00	Mirkin, Letsinger, Mucic, Storhoff, Elghanian/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFORE	U.S. Patent No. 6,417,340, issued 7/9/02
<b>00-714-G</b>	U.S. 09/830,620 Filed 8/15/01	Mirkin, Nguyen/ NANOPARTICLES WITH POLYMER SHELLS	PENDING
<b>00-715-A</b>	U.S. 09/760,500 Filed 1/12/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton; Garamella, Li/ METHOD OF ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES AND PRODUCTS PRODUCED THEREBY	ALLOWED
<b>00-1085-A</b>	U.S.S.N. 09/820,279 Filed 3/28/01	Mirkin, Letsinger, etc./ METHOD AND MATERIALS FOR ASSAYING BIOLOGICAL MATERIALS	ALLOWED
<b>00-1085-G</b>	U.S.S.N. 10/640,618 Filed 8/13/03	Mirkin, Letsinger, etc./ METHOD AND MATERIALS FOR ASSAYING BIOLOGICAL MATERIALS	
<b>00-1086-A</b>	U.S. 09/903,461 Filed 7/11/01	Letsinger, Garamella/ METHOD OF DETECTION BY ENHANCEMENT	U.S. Patent No. 6,602,669, Filed 8/5/03

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
		OF SILVER STAINING	
00-1272-C	U.S.S.N. 10/008,978 Filed 12/7/01	Mirkin, Letsinger, Mucic, Storhoff, Elghanian, Taton, Grimella, Li, Park, Lu/ NANOPARTICLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREOF	PENDING
01-565-A	USSN 10/125,194 Filed 4/18/02	Mirkin, Nguyen, Watson, Park/ OLIGONUCLEOTI DE-MODIFIED ROMP POLYMERS AND CO- POLYMERS	PENDING
01-599-A	U.S.S.N. 10/291,291 Filed 11/08/02	Storhoff/NOVEL THIOL-BASED METHOD FOR ATTACHING OLIGONUCLEOTI DES TO NANOPARTICLES	PENDING
01-661-A	U.S.S.N. 10/034,451 Filed 12/28/01	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
01-661-C	U.S.S.N. 10/153,483 Filed 5/22/02	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
01-661-E	U.S.S.N. 10/397,579 3/26/03	Mirkin, Cao, Jin/ DNA-MODIFIED CORE-SHELL AG/AU NANOCRYSTALS	PENDING
01-1565-A	U.S.S.N. 10/266,983	Park, Taton, Mirkin/ARRAY-	PENDING

ATTY Case No.	Serial No./ Filing Date	Inventors/Title	Status
	Filed 10/08/02	BASED ELECTRICAL DETECTION OF DNA USING NANOPARTICLE PROBES	
01-1633-A	U.S.S.N. 10/266,983 Filed 10/8/02	Park, Taton, Mirkin/NANOPARI CLES HAVING OLIGONUCLEOTI DES ATTACHED THERETO AND USES THEREFOR	PENDING
01-1705-A	U.S.S.N. 10/108,211 Filed 3/27/02	Nam, Park, Mirkin/BIO- BARCODES BASED ON OLIGONUCLEOTI DE-MODIFIED NANOPARTICLES	PENDING
02-338-B	USSN 10/172,428 Filed 6/14/02	Cao, Jin, Nam, Mirkin/MULTICHA NNEL DETECTION USING NANOPARTICLE PROBES WITH RAMAN SPECTROSCOPIC FINGERPRINTS	PENDING
02-338-C	10/431,341 5/7/03	Cao, Jin, Nam, Mirkin/MULTICHA NNEL DETECTION USING NANOPARTICLE PROBES WITH RAMAN SPECTROSCOPIC FINGERPRINTS	PENDING